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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/719,389	06/25/2001	David Holliday	2365-105	8225
6449 7590 11/25/2011 ROTHWELL, FIGG, ERNST & MANBECK, P.C. 1425 K STREET, N.W. SUITE 800 WASHINGTON, DC 20005				
EXAMINER				
HOSSAIN, FARZANA E				
ART UNIT		PAPER NUMBER		
2424				
NOTIFICATION DATE		DELIVERY MODE		
11/25/2011		ELECTRONIC		

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID HOLLIDAY, ROBIN CROSSLEY,
and NICHOLAS JAMES

Appeal 2010-005804
Application 09/719,389
Technology Center 2100

Before ST. JOHN COURTENAY III, JAMES R. HUGHES, and
ANDREW J. DILLON, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's non-final rejection of claims 9-18, 26-37, and 40. (*See n.1 infra*). Claims 19-21 were cancelled during prosecution. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

Invention

The disclosed “invention relates generally to improvements in receivers for television signals.” (Spec. 1). More particularly, the invention on appeal is directed to a receiver that “produces output signals defining an image of events in the programme schedule for displaying on a television screen.” (Abstract).

Representative claims 9 and 14 are illustrative:

9. A receiver for receiving television signals in a plurality of channels each defining a television programme and/or other services provided by a broadcaster, and a channel set identity and a channel subset identity for the channel, the receiver comprising
 - means for storing a reference channel set identity and one or more reference channel subset identities,
 - means for comparing the channel identity and channel subset identity for a channel in a received signal with the reference channel and channel subset identities and
 - means for outputting the received television signal for display of the programme or other services defined thereby depending on the comparison.
14. A receiver for receiving television signals in a plurality of channels each defining a television programme, wherein the signals include sorting data defining a sorted list and scheduling data defining a schedule of programme events, the receiver comprising:

means for sorting the scheduling data depending on the sorting data to produce output signals defining an image of selected events in the programme schedule for display as a sorted schedule on a television screen in an order depending on the sorted list.

*The Rejections*¹

1. Claim 14 stands rejected under 35 U.S.C. §112, first paragraph, as a single means claim.
2. Claims 9-13 and 26-36 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Ellis (U.S. Pat. 5,760,821)(hereinafter “Ellis ‘821”).
3. Claims 14, 15, and 40 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Ellis (U.S. Pat. Pub. 2007/0271582) (hereinafter “Ellis ‘582”).
4. Claims 16-18 and 37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Usui (U.S. Pat. 5,808,694), Yuen (WO 97/47136), Eyer (U.S. Pat. 6,160,545)(hereinafter “Eyer ‘545”), and Eyer (U.S. Pat. 5,801,753)(hereinafter “Eyer ‘753”).

¹ The Examiner withdrew the §103 rejection of claims 1-3, 5-8, 22, 38 and 39 over Ellis (US Pat. 5,548,338) and Yuen (US Pat. 6,028,599). (Ans. 3). The Examiner also withdrew the §103 rejection of claims 4 and 23-25 over Ellis (US Pat. 5,548,338), Yuen, and Terasawa (US Pat. 6,147,714). (Ans. 3).

Rejection under 35 U.S.C. § 112, first paragraph

The Examiner set forth new grounds of rejection for claim 14 under 35 U.S.C. 112, first paragraph, as a single means claim (scope of enablement). At the outset, we observe that Appellants have elected to maintain the appeal as permitted under 37 C.F.R. §41.39(b)(2). (Reply Br. 1).

Appellants contend that “claim 14 effectively recites two means clauses: means for sorting and means for producing output signals. The corresponding structure described in the specification includes software configured to (1) compute index lists of events by sorting data, and (2) transmit the sorted lists. Thus, claim 14 is not a single means claim which covers every conceivable means for achieving the stated purpose.” (Reply Br. 2).

We disagree. We decline Appellants’ invitation to read unclaimed limitations into the claim (second means). We observe only one “means for sorting” that is positively recited in claim 14:

means for sorting the scheduling data depending on the sorting data to produce output signals defining an image of selected events in the programme schedule for display as a sorted schedule on a television screen in an order depending on the sorted list.

Since there is only one recited “means,” we conclude that claim 14 is a single means claim that is improper under 35 U.S.C. § 112, first paragraph (scope of enablement). In essence, claim 14 covers *every conceivable means* for achieving the desired result. The Specification, however, discloses only those means known to Appellants. *See In re Hyatt*, 708 F.2d 712, 714 (Fed.

Cir. 1983); *see also* MPEP § 2164.08(a). Therefore, we sustain the Examiner's rejection of claim 14 under 35 U.S.C. § 112, first paragraph, as a single means claim.

Rejection of claims 9-13 and 26-36 under § 102

Appellants argue claims 9-13 and 26-36 as a group. We select representative claim 9 to decide the appeal for this group. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUE

Based upon our review of the administrative record, we have determined that the following issue is dispositive in this appeal regarding representative claim 9:

Under §102, did the Examiner err in finding that the cited Ellis '821 reference discloses:

means for comparing the channel identity and channel subset identity for a channel in a received signal with the reference channel and channel subset identities and

means for outputting the received television signal for display of the programme or other services defined thereby depending on the comparison,

within the meaning of representative claim 9?

Factual Findings

We adopt the Examiner's findings in the Answer and non-final Office Action (mailed 3-19-2009), with respect to the limitations at issue, as our own. (Ans. 5).

Regarding representative claim 9, Appellants present the following contentions:

Ellis '821 does not disclose any elements or components which perform the recited functions of "comparing the channel identity and channel subset identity for a channel in a received signal with the reference channel and channel subset identities" and "outputting the received television signal for display of the programme or other services defined thereby depending on the comparison." Accordingly, Ellis '821 and Bennington '556 [incorporated by reference] does not disclose the recited functions corresponding to the "means for comparing" and the "means for outputting" limitations. (Reply Br. 4).

During *ex parte* prosecution, the Patent & Trademark Office (PTO) determines the scope of the claims by giving the language "the broadest reasonable construction 'in light of the specification as it would be interpreted by one of ordinary skill in the art.'" *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005) (en banc) (*quoting In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004)).

Here, under a broad but reasonable interpretation, the Examiner reads the claimed "channel set identity" on the Ellis '821 group number for the Colorado region (col. 3, l. 49), and the Examiner reads the claimed "channel subset identity" on the Ellis '821 group number for local schedules including the cable headend of Denver for the channel or the scheduling information (col. 3, l. 50-65). (Ans. 13-14).

We observe that Appellants do not directly address the aforementioned findings by the Examiner. While Appellants aver that "Ellis does not teach anything about selection of available channels" (Reply Br. 3), we observe that a "means for selection" is not positively recited in claim 9.

Nor are we persuaded that Ellis ‘821 does not disclose the recited “means for outputting.” As acknowledged by Appellants, “Ellis discloses an information localization filter (53) which uses group numbers as filtering criteria to transform a national program schedule (10) into a localized version (55), which is then stored in the set-top box.” (Reply Br. 3). In particular, we note that Ellis ‘821 discloses that “the scheduled is localized according to the present invention *for display on the viewer television receiver 54.*” (Col. 3, ll. 27-29; emphasis added).

On this record, Appellants’ arguments are unpersuasive regarding the Examiner’s finding of anticipation. Therefore, we sustain the § 102 rejection of representative claim 9, and dependent claims 10-13 and 26-36 (not argued separately) which fall therewith. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Rejection of claims 14, 15, and 40 under § 102

We consider next the Examiner’s rejection of claims 14, 15, and 40 as anticipated by “Ellis ‘582.” (*See* Ans. 7-8).

Appellants contend that “[i]n evaluating the patentability of a ‘means-plus-function’ clause, the PTO must consider the structure described in the applicants’ specification that corresponds to the recited means,” citing 35 U.S.C. §112(6) and *In re Donaldson*, 16 F.3d 1189, 1195 (Fed. Cir. 1994). (App. Br. 10).

However, *Donaldson* does not affect the holding of *Hyatt* to the effect that a single means claim does not comply with the enablement requirement of 35 U.S.C. 112, first paragraph (*see* discussion above regarding claim 14

as a single means claim). As *Donaldson* applies only to an interpretation of a limitation drafted to correspond to 35 U.S.C. § 112, sixth paragraph, which by its terms is limited to “an element in a claim to a combination,” it does not affect a limitation in a claim which is *not directed to a combination* (i.e., single means claim 14). For this reason we find Appellants’ arguments unavailing regarding any purported deficiency in Ellis ‘582 as to structure that the Examiner corresponds to the recited single means of claim 14.

However, we do find persuasive Appellants’ additional contention that the Examiner has not shown where Ellis ‘582 discloses “receiving television signals in a plurality of channels . . . wherein *the signals include sorting data defining a sorted list*,” as recited in the preamble of claim 14 (emphasis added; *see also* App. Br. 11).

Based upon our review of claim 14, we accord weight to the statement of intended use in the preamble (“A receiver for receiving television signals . . . the signals including sorting data defining a sorted list and *scheduling data defining a schedule of programme events*”), because the recited preamble elements “*scheduling data*” and “*schedule of programme events*” provide clear antecedent basis for “the scheduling data” and “the programme schedule” which are recited in the body of claim 14. *See Eaton Corp. v. Rockwell Int’l Corp.*, 323 F.3d 1332, 1339 (Fed. Cir. 2003) (When the limitations in the body of the claim “rely upon and derive antecedent basis from the preamble, then the preamble may act as a necessary component of the claimed invention.”).

Here, we observe that the “sort order” relied on by the Examiner (Ans. 16) in paragraph 0076 of Ellis ‘582 is performed by a *person* (“the user may specify a priority or sort order.”). Therefore, we agree with Appellants that the Examiner has not shown where Ellis ‘582 discloses “A receiver for *receiving television signals* in a plurality of channels . . . wherein *the signals include sorting data defining a sorted list* . . . the receiver comprising means for sorting the scheduling data . . .” (claim 14, emphasis added; *see also* App. Br. 11). Accordingly, we reverse the Examiner anticipation rejection of independent claim 14 and associated dependent claims 15 and 40 that stand therewith.

Rejection of claims 16-18 and 37 under § 103

Lastly, we consider the Examiner’s rejection of claims 16-18 and 37 as unpatentable over the combination of Usui, Yuen, Eyer ‘545, and Eyer ‘753.

In reviewing the multiple citations to disparate portions of Eyer (Ans. 17, last paragraph), we find the weight of the evidence supports Appellants’ contention that “[n]o combination of these references would achieve a system where EPG [Electronic Programming Guide] data for first and second networks is normally from the respective networks, but additional schedule data is received from the first network for either of the first and second networks in response to a user request.” (App. Br. 19).

Therefore, we agree with Appellants that at least the following limitation of independent claim 16 is not taught or fairly suggested by the Examiner proffered combination of references: “means for receiving and

decoding additional programme schedule data from the first network for either of the first or second broadcast network, in response to a user request.” Accordingly, we reverse the Examiner obviousness rejection of independent claim 16 and associated dependent claims 17, 18, and 37 that stand therewith.

DECISION

We affirm the Examiner’s rejection of claim 14 under 35 U.S.C. §112, first paragraph as a single means claim (scope of enablement).

We affirm the Examiner’s § 102 rejection of claims 9-13 and 26-36.

We reverse the Examiner’s § 102 rejection of claims 14, 15, and 40.

We reverse the Examiner’s § 103 rejection of claims 16-18 and 37.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

ORDER

AFFIRMED-IN-PART